Remarks

Applicant has carefully reviewed the application in light of the Office Action dated January 29, 2003. At the time of the Office Action, Claims 1-22 and 24-50 were pending in the application. No pending claims have been amended or canceled. Applicant respectfully requests reconsideration of all pending claims.

Section 101 Rejections

The Examiner rejects Claims 1-22 and 24-50 under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The patent laws define patentable subject matter as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto." See 35 U.S.C. § 101. When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete and tangible result. This then satisfies the requirements of 35 U.S.C. § 101. *See In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q. 2d 1545, 1558 (Fed. Cir. 1994); *see also State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 U.S.P.Q. 2d 1596, 1601-02 (Fed. Cir. 1998) and www.uspto.gov/web/menu/pbmethod/trangmaterials.ppt. While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. § 101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. § 101. *See AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier limiting principles regarding § 101 and announced more expansive principles formulated with computer technology in mind); *see also In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356). Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law.

Applicant respectfully submits that, for example, Claim 1 produces a useful, concrete, and tangible result. "Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101." (M.P.E.P. § 2106). Indeed, a method or process remains statutory even if some or all of the steps therein can be performed in the human mind, with the aid of the human mind, or because it may be necessary

for one performing the method or process to think. *See In re Musgrave*, 431 F.2d at 893, 167 U.S.P.Q. at 289. Claim 1 is directed to an online communication schema for an online vehicle ordering and tracking system. Accordingly, online vehicle ordering and tracking is one practical application of Claim 1. As such, the invention recited in Claims 1-22 and 24-50 is not merely an abstract idea as suggested by the Examiner.

For at least the reasons discussed above in regard to Claim 1, Applicant respectfully requests that Examiner's rejection of Claims 1-22 and 24-50 under 35 U.S.C. § 101 be withdrawn.

Section 112 Rejections

The Examiner rejects Claims 1, 17, 31, and 45 under:

1) 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention; and

2) under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant respectfully traverses the Examiner's rejections for at least the following reasons. For example, the specification recites "The tagged configuration parameter 1084 contains data of the tagged vehicle: VIN 1085, stock number 1086, item number 1087, order line number 1088, matched configuration 1089, configured model 1090, *tagged dealer 1121, selected dealer 1122*, vehicle initial status 1123 (new, used, in-stock), and locate search identifier 1124." (Specification, p. 38, l. 31 – p. 39, l. 2; emphasis added). In another example, the specification recites "Tagged dealer 1121 is a tag for the dealer code of the dealer that has the requested vehicle. Selected dealer 1122 is the tag for the dealer code that the customer has selected from whom to purchase the vehicle." (Specification, p. 39, ll. 25-28). Other portions of the specification may also support "a first dealer identifier of a first dealer having the tagged vehicle in inventory and a second dealer identifier of a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory" as recited, in part, by Claims 1, 17, 31, and 45. Accordingly, Applicant respectfully requests that both 35 U.S.C. § 112 rejections be withdrawn.

Section 103 Rejections

The Examiner rejects Claims 1, 2-9, 11, 12, 15-22, 25, 26, 29-37, 39, 40, and 43-50 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,282,517 B1 issued to *Wolfe* ("*Wolfe*") in view of Tittel et al. "XML for Dummies" (hereinafter "*Tittel*").

The Examiner asserts that "the limitation '...a first dealer identifier of a first dealer having the tagged vehicle in inventory and a second dealer identifier of a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory' is not properly supported by the specification. In addition, it is unclear what this limitation means with regard to the Applicant's invention." (Office Action, p. 12). Applicant respectfully traverses this assertion for at least the reasons described above with regard to the §112 rejections. Accordingly, Applicant respectfully requests that Examiner consider the Applicant's arguments in the Response filed November 6, 2002. For the convenience of the Examiner, Applicant's previous arguments are substantially reproduced below.

Claim 1 recites, in part, "An online communication schema for an online vehicle ordering and tracking system, comprising a search request message including at least one search criteria ... and a weighting of each criterion ... a search reply message including a list of vehicles matching the at least one search criteria ... and a plurality of vehicle configuration parameters of the vehicles matching at least one search criteria, including vehicle identifier, make, model, dealer identifier, price, and color ... and a tag request message comprising tagged vehicle parameters, the tagged vehicle parameters including the vehicle identifier, a first dealer identifier of a first dealer having the tagged vehicle in inventory ... a second dealer identifier of a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory." *Wolfe* fails to teach, suggest, or disclose various aspects of Claim 1.

For example, *Wolfe* fails to teach, suggest, or disclose "a tag request message comprising tagged vehicle parameters, the tagged vehicle parameters including a vehicle identifier, a first dealer identifier of a first dealer having the tagged vehicle in inventory ... a second dealer identifier of a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory," as recited, in part, in amended Claim 1. The Examiner claims that *Wolfe*'s new vehicle purchase request record describes the tag request

message of the present invention. (Office Action, p. 4). Applicants do not concede this contention and reserve the right to dispute it later, but even if correct, *Wolfe* fails to teach, suggest, or disclose "the tagged vehicle parameters including a vehicle identifier, a first dealer identifier of a first dealer having the tagged vehicle in inventory" and "a second dealer identifier of a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory."

Instead, *Wolfe* discloses a system that determines the one or more appropriate dealers for a generic new or used vehicle (or a specific dealer for a specific used vehicle) and generates a different purchase request record for each dealer. (*See, generally, Wolfe*, c. 11, l. 9 - c. 12, l. 40). For example, the new vehicle purchase request record in *Wolfe* includes a single dealer identification number (706), a vehicle make (708), and a vehicle model (710). (*See Wolfe*, c. 11, ll. 9-33; FIGURE 7; FIGURE 8). In other words, the new request record does not disclose or suggest a second dealer identifier selected by a user. Next, a buyer-dealer association module (610) identifies the appropriate dealers based on exclusive sales regions, vehicle make, and/or zip code. (*See Wolfe*, c. 12, ll. 10-29). Then, regardless of whether it is a new vehicle or a used vehicle that matches a request, the buyer-dealer association module (610) creates "the necessary number of purchase request records, *one for each* of the plurality of dealer identification numbers." (*Wolfe*, c. 12, ll. 31-40 (emphasis added); *see id.*, c. 13, ll. 8-17). Accordingly, Applicant respectfully submits that *Wolfe* fails to teach, suggest, or disclose a tag request message comprising "the tagged vehicle parameters including ... a first dealer identifier of a first dealer having the tagged vehicle in inventory ... and a second dealer identifier of a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory," as recited, in part, in amended Claim 1 (emphasis added).

Applicant respectfully requests that the Examiner withdraw the *Wolfe – Tittel* combination as improper because a prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.,* 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied,* 469 U.S. 851 (1984); M.P.E.P. §2141.02. As described above, *Wolfe* fails to teach, suggest, or disclose "the tagged vehicle parameters including ... a first dealer identifier of a first dealer having the tagged vehicle in inventory" and "a second dealer identifier of a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory." Instead, the

Examiner's primary reference – *Wolfe* – specifically teaches away from this concept. Generally, *Wolfe* discloses a "Data Center system [that] determines at least one appropriate dealer to receive the purchase request" and stores the request in "the appropriate dealer's <u>exclusive</u> database region." (*Wolfe*, Abstract (emphasis added)).

In particular, *Wolfe* teaches that a dealer is "assigned an <u>exclusive</u> database region in the system database." (*Wolfe*, c. 4, ll. 49-54 (emphasis added)). The seller's <u>exclusive</u> database region may be physical or virtual, (*Wolfe*, c. 2, ll. 31-41 (emphasis added)), and *"may only be accessed by the assigned dealer* and the Data Center system programs." (*Wolfe*, c. 6, ll. 65-67 (emphasis added)). After determining one or more appropriate sellers for a purchase request, the buyer-dealer association module (610) creates "the necessary number of purchase request records, <u>one for each of the plurality of dealer identification numbers,</u>" (*Wolfe*, c. 12, ll. 31-34 (emphasis added); *see id.*, c. 13, ll. 8-17), and "the system immediately stores the purchase request in the appropriate seller's <u>exclusive</u> database region." (*Wolfe*, c. 5, ll. 5-7 (emphasis added); *see also id.*, c. 3, ll. 5-14). In other words, each purchase request record is linked to a single dealer and stored in the dealer's <u>exclusive</u> database region in *Wolfe*. This sort of one-to-one correspondence between "purchase request record" and "dealer identifier" required by Wolfe specifically teaches away from "a tag request message comprising tagged vehicle parameters ... including ... a first dealer identifier ... and a second dealer identifier."

Not only does *Wolfe* teach away from "a second dealer identifier selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory," but if *Wolfe* were modified to allow such a capability, the "proposed modification would render the prior invention being modified unsatisfactory for its intended purpose," and, therefore, "there is no suggestion or motivation to make the proposed modification." (MPEP §2143.01). Also, the "proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified," and, therefore, "the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP §2143.01. As described above, the fundamental principle of *Wolfe* includes creating a purchase request record and storing the new record in "an exclusive database region for each participating dealer." (*Wolfe*, Abstract). The exclusive database region is necessary in *Wolfe* to allow each dealer, upon logging in, "immediate access to its exclusive database region and the contents thereof." (*Wolfe*, c. 7, l. 33-40). As *Wolfe* is necessarily limited to "an exclusive database region for each participating

dealer," (*Wolfe*, Abstract), it is incapable of adding a purchase request record to an exclusive database region, wherein the record would include "a second dealer identifier selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory." For example, in *Wolfe*, "the collection of all records associated with the seller advantageously comprises a virtual exclusive database region." (*Wolfe*, c. 2, l. 38-41). Modifying *Wolfe* to include "a second dealer identifier selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory", as specifically recited by Claim 1, defeats any "exclusive database region" as required by *Wolfe*.

Accordingly, Applicant respectfully submits that the proposed modifications of *Wolfe* are improper because *Wolfe* teaches away from "the tagged vehicle parameters including ... a first dealer identifier of a first dealer having the tagged vehicle in inventory ... and a second dealer identifier of a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory" as recited, in part, by independent Claim 1. For at least these reasons, Applicant requests reconsideration and allowance of independent Claim 1 and all claims depending therefrom.

For at least the reasons stated above with regard to Claim 1, Applicant respectfully requests reconsideration and allowance of independent Claims 17, 31, and 45 and all claims depending therefrom.

The Examiner rejects Claims 13, 14, 27, 28, 41, and 42 under 35 U.S.C. §103(a) as being unpatenable over *Wolfe* in view of Korth et al. "Database System Concepts." For at least the reasons stated above in regard to Claim 1, and because Claims 4, 13, 14, 27, 28, 41, and 42 depend from Independent Claims shown above to be allowable, Applicant respectfully requests reconsideration and allowance of Claims 13, 14, 27, 28, 41, and 42.

The Examiner rejects Claims 10, 24, and 38 under 35 U.S.C. §103(a) as being unpatenable over *Wolfe* in view of St. Laurent "Cookies." For at least the reasons stated above in regard to Claim 1, and because Claims 10, 24, and 38 depend from Independent Claims shown above to be allowable, Applicant respectfully requests reconsideration and allowance of Claims 10, 24, and 38.

Conclusion

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and allowance of all pending Claims.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees necessary for advancement of the prosecution of this case or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants

Samir A. Bhavsar
Reg. No. 41,617

Date: _February 18_, 2003

CORRESPONDENCE ADDRESS:

Customer Number or Bar Code Label:

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